The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

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U.S. PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES ____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANTHONY A. SHAH-NAZAROFF, JEAN M. GOLDSCHMIDT, KENNETH ALAN MOORE, DAVID N. HACKSON and GREGORY D. BUSCHECK

Appeal No. 2003-1230 Application No. 09/183,282

ON BRIEF

Before RUGGIERO, LEVY and MACDONALD, Administrative Patent Judges.

MACDONALD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-33.

Invention

Appellants' invention relates to an electronic programming guide (Appellants' title). The guide displays entertainment data from a stored database. The stored database includes a record

Application No. 09/183,282

comprising an entertainment selection identifier and a first group of sets of entertainment system data each set having an identifier portion and a data portion. The record further comprises a second group of sets of entertainment system data each set having an identifier portion indicating it is linked to a set in the first group and a second portion comprising instructions to be performed. See Appellants' specification, page 13, line 8, to page 14, line 24.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method for managing entertainment system data, comprising:

obtaining a record corresponding to a first entertainment selection;

presenting a first set of entertainment system data in the obtained record corresponding to the first entertainment selection on a display device;

presenting a selectable identifier corresponding to the first set of entertainment system data on the display device;

receiving a selection of the selectable identifier;

accessing instructions linked to the selectable identifier;

performing a search based on the accessed instructions for a second entertainment selection having a corresponding second set of entertainment system data related to the first set of entertainment system data; and

presenting a result of the search on the display device.

References

The references relied on by the Examiner are as follows:

Dunn	5,945,987	Aug. 31, 1999
		(Filed May 5, 1995)
Williams et al. (Williams)	6,157,411	Dec. 5, 2000
		(Filed June 12, 1997)

Application No. 09/183,282

Rejections At Issue

Claims 1-10 and 15-33 stand rejected under 35 U.S.C. § 103 as being obvious over Dunn.

Claims 11-14 stand rejected under 35 U.S.C. § 103 as being obvious over Williams.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

Related Issue

The Examiner has objected to the amendment filed on 04/03/02 under 35 U.S.C. § 132 as introducing new matter into the disclosure. This issue is not before us as it may be reviewed only by way of petition to the Commissioner. See 37 CFR § 1.181; MPEP § 706.01; MPEP § 1201; and MPEP § 2163.06 (II).²

If the examiner concludes that the claimed subject matter is not supported in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under 35 U.S.C. 112, first paragraph or denial of the benefit of the filing date of a previously filed application. The claim should not be rejected or objected to on the ground of new matter.

The Examiner should further note that we were able to find support for the claimed subject matter in the application as filed. See the discussion at pages 8-9 of Appellants' brief.

¹ Appellants filed an appeal brief on October 8, 2002. Appellants filed a reply brief on February 10, 2003. The Examiner mailed out an Examiner's Answer on December 6, 2002.

² The Examiner should note that this objection does not conform to current USPTO practice as found at MPEP § 2163.01 Support for the Claimed Subject Matter in Disclosure:

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 1-33 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal the claims stand or fall together in three groupings:

Claims 1-10, 15-23, and 26-33 as Group I;

Claims 24 and 25, as Group II; and

Claims 11-14, as Group III.

See page 7 of the brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 9-14 of the brief and pages 2-9 of the reply brief. Appellants have fully met the requirements of 37 CFR. § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Application No. 09/183,282

We will, thereby, consider Appellants' claims as standing or falling together in the three groups noted above, and we will treat:

Claim 1 as a representative claim of Group I;

Claim 24 as a representative claim of Group II; and

Claim 11 as a representative claim of Group III.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim.

In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). See also In re Watts, 354 F.3d 1362, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1-10, 15-23, and 26-33 under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would <u>not</u> have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-10, 15-23, and 26-33. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching

in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. See also Piasecki, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue (Appeal Brief, page 11), "Dunn does not teach or suggest 'performing a search based on accessed instructions" as recited at line 9 of claim 1. We note that line 8 of claim 1, also requires that the instructions be "linked to the selectable identifier."

Our reviewing court states in **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those

words by persons skilled in the relevant art." **Texas Digital Sys. Inc v. Telegenix Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), **cert. denied**, 538 U.S. 1058 (2003).

Upon our review of Appellants' specification, we fail to find any definition of the term "linked" that is different from the ordinary meaning. We find the ordinary meaning of the term "linked" is best found in the dictionary. We note that the definition most suitable for "linked" is "to connect with or as if with a link".

We appreciate the Examiner's position that "linked" is met by column 3, lines 13-41 of Dunn. However, we find that the claim language precludes reading on merely executing a search based on generic instructions used by all the selectable identifiers. The "linked" limitation of Appellants' claim requires that each selectable identifier have its own unique instructions. See, for example, Appellants' figure 5, items 520 and 521.

Therefore, for the reasons above, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 24 and 25 under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would <u>not</u> have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 24 and 25. Accordingly, we reverse.

³ Dictionary.com. Copy provided to Appellants.

With respect to dependent claim 24, the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness. Claim 24 stands rejected under 35 U.S.C. § 103 as being obvious over Dunn. However, claim 24 depends from claim 11, and yet the Examiner has not rejected claim 11 under 35 U.S.C. § 103 as being obvious over Dunn. Without a showing of how the limitations of claim 11 are taught or suggested by Dunn, it is not possible for the Examiner to meet the initial burden of establishing a **prima facie** case.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claims 11-14 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would <u>not</u> have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 11-14. Accordingly, we reverse.

With respect to independent claim 11, we find Appellants' argument at page 13 of the brief persuasive. In addition, we note that Williams fails to teach, "instructions linked to the identifier" as required by line 9 of the claim. See the discussion above with respect to claim 1. The Examiner has not discussed why this limitation of claim 11 is taught or suggested by Williams. Therefore, the Examiner has not met the initial burden of establishing a **prima facie** case of obviousness.

For the reasons set forth above, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-33.

REVERSED

Joseph Verguero	
JOSEPH F. RUGGIERO)
Administrative Patent Judge	j
H Sha)))
STHART GIRLING) BOARD OF PATENT
STUART S. LEVY) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
ALLEN R. MACDONALD Administrative Patent Judge)))

ARM:psb

Lawrence M. Cho Blakely Sokoloff Taylor & Zafman 12400 Wilshire Boulevard 7th Floor Los Angeles, CA 90025

ATTACHMENT

7 entries found for linked.

link¹ P Pronunciation Key (lingk)

- 1. One of the rings or loops forming a chain.
 - a. A unit in a connected series of units: links of sausage; one link in a molecular chain.
 - b. A unit in a transportation or communications system.
 - c. A connecting element; a tie or bond: grandparents, our link with the past.
 - a. An association; a relationship: The Alumnae Association is my link to the school's present administration.
 - b. A causal, parallel, or reciprocal relationship; a correlation: Researchers have detected a link between smoking and heart disease.
- 4. A cuff link.
- 5. Abbr. li A unit of length used in surveying, equal to 0.01 chain, 7.92 inches, or about 20.12 centimeters.
- 6. A rod or lever transmitting motion in a machine.
- 7. <u>Computer Science</u>. A segment of text or a graphical item that serves as a cross-reference between parts of a hypertext document or between files or hypertext documents. Also called **hotlink**, **hyperlink**.

v. linked, link·ing, links

http://dictionary.reference.com/search?q=linked

Dictionary.com/linked

1. To connect with or as if with a link: linked the rings to form a chain. See Synonyms at join.

2. <u>Computer Science.</u> To make a hypertext link in: linked

her webpage to her employer's homepage.

- 1. To become connected with or as if with a link: The molecules linked to form a polymer.
- 2. Computer Science. To follow a hypertext link: With a click of the mouse, I linked to the company's website.

[Middle English linke, of Scandinavian origin, akin to Old Norse hlekkr; *hlenkr, from *hlenkr.]

link er *n*.

[Download or Buy Now]

Source: The American Heritage® Dictionary of the English

Language, Fourth Edition

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linked P Pronunciation Key (l'Ingkt)

- 1. Connected, especially by or as if by links.
- 2. Genetics Exhibiting linkage.
- 3. Computer Science. Provided with links.

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Source: The American Heritage® Dictionary of the English Language, Fourth Edition

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linked (lingkt)

adj.

Exhibiting linkage.

Source: The American Heritage® Stedman's Medical 12

Dictionary

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Main Entry: linked

Pronunciation: 'li[ng](k)t

Function: adjective

: marked by linkage and especially genetic linkage < linked

genes>

Source: Merriam-Webster Medical Dictionary, © 2002

Merriam-Webster, Inc.

linked

Link \Link\ (\l[i^][ng]k), v. t. [imp. & p. p. Linked (\l[i^][ng]kt); p. pr. & vb. n. Linking.] To connect or unite with a link or as with a link; to join; to attach; to unite; to couple.

All the tribes and nations that composed it [the Roman Empire] were linked together, not only by the same laws and the same government, but by all the facilities of commodious intercourse, and of frequent communication. —Eustace.

[<u>Free Trial - Merriam-Webster Unabridged.</u>]
<u>Source: Webster's Revised Unabridged Dictionary,</u> © 1996, 1998 MICRA, Inc.

linked

adj: connected by a link, as railway cars or trailer trucks
[syn: coupled, joined]

Source: WordNet ® 2.0, © 2003 Princeton University

linked

linked: in Cancer WEB's On-line Medical Dictionary

Source: On-line Medical Dictionary, © 1997-98 Academic Medical Publishing & CancerWEB

13

Perform a new search, or try your search for "linked"